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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,946	06/22/2001	Mark P. Ashby	018413-331	9583

7590

07/14/2004

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EXAMINER

COZART, JERMIE E

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

Office Action Summary	Application No. 09/806,946	Applicant(s) ASHBY ET AL.	
	Examiner Jermie Cozart	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 1, line 8, "the" in its second occurrence is used incorrectly in the sentence and is a clear grammatical error. Appropriate correction is required.

Claim Objections

2. Claim 10 is objected to because of the following informalities: In claim 10, line 4, a colon should immediately follow "comprising". Therefore it is recommended to change "comprising" to - -comprising: - -. Appropriate correction is required.

3. Claims 10-15 are objected to because they include reference characters which are not enclosed within parentheses.

4. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 15 contains the trademark/trade name TEFLON. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a fluoropolymer and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Muni et al. (6,190,332).

Muni`332 discloses a guide wire (10) having a substantially cylindrical mandrel (26), wherein the mandrel has one or more segments (28, 46) each having a uniform initial diameter not exceeding a maximal diameter. Muni`332 discloses providing a wire

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(26) of a diameter greater than the maximal diameter as shown in Figure 3A, and reducing the diameter of the wire to less than maximal diameter such that a mandrel (26) is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel (26) as shown in Figures 3A-3C and disclosed in column 5, line 47 – column 6, line 13. Muni`332 discloses the step of reducing comprising center-less grinding, and a coil (32) being affixed to the mandrel, wherein the coil is radiopaque. The wire (26) is made of stainless steel (col. 4, line 66 – col. 5, line 1). See column 5, lines 14 – 27; column 6, lines 7-13; and Figures 2 – 3C for further clarification.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (6,190,332) in view of Cornish et al. (6,132,389).

Muni`332 discloses all of the claimed subject matter except for the step of coating at least a portion of the mandrel with a hydrophilic coating, or coating the mandrel with a lubricious coating, wherein the lubricious coating is applied to all but a proximal portion of the mandrel.

Cornish`389 discloses coating at least a portion of mandrel (12) with a hydrophilic coating, and coating the mandrel with a lubricious coating (26), wherein the

lubricious coating may optionally be applied is applied to any additional portion. See *column 3, lines 34 – 60, and Figures 1 and 4 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to coat at least a portion of the mandrel of Muni`332 with a hydrophilic coating, and to coat the mandrel of Muni`332 with a lubricious coating, wherein the lubricious coating is optionally applied to selective portions, in light of the teachings of Cornish`389, in order to effectively reduce the surface friction of the mandrel.

12. Claims 6, 7, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni et al. (6,190,332) in view of Applicant's Admitted Prior Art (AAPA).

Muni`332 discloses all of the claimed subject matter except for the step of providing a wire comprising unwinding the wire from a spool, straightening the wire, or cutting the wire to a desired length.

AAPA at page 1 of the specification that it is known in the method of manufacturing a guide wire to select a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to select the wire of Muni`332 from a single drawn/spooled wire, straighten the spooled wire, and cut the wire to the desired length, in light of the teachings of AAPA, in order to effectively deliver and provide a uniform starting material for the core section of the guide wire.

13. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muni/AAPA as applied to claim 11 above, and further in view of Cornish et al. (6,132,389).

Muni/AAPA as modified above discloses all of the claimed subject matter except for the step of treating the guidewire with a lubricious compound such as Teflon.

Cornish`389 discloses the step of treating the guidewire (12) with a lubricious coating (26) such as Teflon. *See column 3, lines 34 – 60, and Figures 1 and 4 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to treat the guidewire of Muni`332/AAPA with a lubricious compound such as Teflon, in light of the teachings of Cornish`389, in order to effectively reduce the surface friction of the guidewire.

Response to Arguments

14. Applicant's arguments filed 3/12/04 have been fully considered but they are not persuasive.

Applicant argues that Muni does not disclose the wire being made from stainless steel or titanium.

In response, the Examiner maintains that Muni clearly discloses the wire (26) being made of stainless steel (col. 4, line 66 – col. 5, line 1).

Conclusion


15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 703-305-0126. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC
July 12, 2004


DAVID P. BRYANT
PRIMARY EXAMINER